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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 10/699,964   | 11/03/2003  | Patricia M. Reo      | REO001P               | 5086             |
| 36927  | 7590        | 03/21/2005           | EXAMINER              |                  |
| MICHAEL R. PHILIPS<br>5 TURNBERRY CIRCLE<br>P.O. BOX 1818<br>TOMS RIVER, NJ 08754-1818 |             |                      | CHEVALIER, ALICIA ANN |                  |
|  |             |                      | ART UNIT              | PAPER NUMBER     |
|  |             |                      | 1772                  |                  |

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/699,964

Applicant(s)

REO, PATRICIA M.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1. Claims 1-14 are pending in the application.

#### ***Examiner's Comment***

2. The term “hypo-allergenic” was coined for marketing products and is not a medical or FDA approved term or standard. Furthermore, Applicant’s specification does not disclose what they considered to be “hypo-allergenic” adhesives, i.e. composition or what specific additive makes it “hypo-allergenic”. Therefore, the term “hypo-allergenic” adhesive is taken to mean any type of adhesive.

#### ***Claim Objections***

3. Claim 8 objected to because of the following informalities: “a coefficient of friction against paper in the range of 0.50-0.90” should read “a coefficient of friction against paper in the range of 0.50-0.90”.

Claims 10 and 11 objected to because of the following informalities: “viewed in plan” should read “viewed in plane”.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Yonkers (U.S. Patent No. 3,985,383).

Regarding Applicant's claim 1, Yonkers discloses a paper handling aid (*indexing device, title and col. 1, lines 6-12*) comprising a substantially planar membrane formed of a flexible, frictional material (*col. 2, lines 59-62 and col. 3, lines 14-29*) and sized to fit on the pad portion of a finger (*figure 1*), an adhesive coating on a first surface of the membrane (*col. 2, line 68 through col. 3, line 1*) and where in use the adhesive is in contact with the pad portion of the finger (*col. 2, line 68 through col. 3, line 2 and figure 1*).

Regarding Applicant's claim 2, Yonkers discloses that the paper handling aid further comprises a plurality of protuberances formed on a second surface of the membrane (*figure 4 and col. 3, lines 59-62*).

Regarding Applicant's claim 3, Yonkers discloses that membrane material is elastomeric (*col. 3, lines 21-22*).

Regarding Applicant's claim 4, Yonkers implicitly implies that the adhesive adheres substantially permanently to the first surface of the membrane and adheres releasably to the pad portion of the figure, since the reference does not disclose that the friction material and adhesive separate and the reference does not disclose that the adhesive permanently attaches to a persons finger.

Regarding Applicant's claims 5 and 6, Yonkers' pressure sensitive adhesive (*col. 2, line 68 through col. 3, line 1*) is deemed to be a hypo-allergenic adhesive, see above examiner's comment.

Regarding Applicant's claims 7 and 12, Yonkers discloses that the membrane material has a sufficiently high coefficient of friction to improve the task of handling, sorting and separating paper (*col. 1, lines 6-12 and col. 3, lines 15-18*).

Regarding Applicant's claim 10, Yonkers discloses that the paper handling aid is substantially round when viewed in plane (*figure 3*).

Regarding Applicant's claim 11, Yonkers discloses that the paper handling aid is non-round when viewed in plane (*figure 6*).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 9, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers.

Yonkers is relied upon as described above.

Yonkers discloses that the traction material, i.e. membrane, has a very high coefficient of friction in order to facilitate handling and separating paper (*abstract, col. 1, lines 6-12 and col. 3, lines 15-18*)

Yonkers fails to disclose that the coefficient of friction is in the range of 0.50-0.90, more specifically 0.80.

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Therefore, the exact coefficient of friction of the membrane is deemed to be a result effective variable with regard to the force needed to handle paper. It would require routine experimentation to determine the optimum value of a result effective variable, such as the coefficient of friction, in the absence of a showing of criticality in the claimed coefficient of friction. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Powell (U.S. Patent No. 5,547,465) and Scott (U.S. Patent No. 3,283,888) both disclose similar paper handling aids.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Alicia Chevalier

3/17/05